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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,155	10/20/2000	Sandrine Decoster	05725.0793-00000	7711

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1619

DATE MAILED: 11/19/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/692,155

Applicant(s)

DECOSTER ET AL.

Examiner

Gina C. Yu

Art Unit

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Amendment and Response filed on August 29, 2001. Claims 1-95 are pending.

Specification

Specification is objected to because the terms "formula (II)" in the amended claim 1 (2) do not correspond to the disclosure in the specification. The amendment of the claim calls for also amending the specification.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 77 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "satisfactory" in claim 77 is a relative term which renders the claim indefinite. Applicants argue that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention since the term is used to describe adequate foaming and detergent properties of a washing base composition. Examiner takes the position that whether a composition renders "satisfactory" foaming or deterative property to perform the said utility is entirely subjective to the user, where the specification does not provide a standard for ascertaining the requisite degree. The rejection is maintained.

Claim 85 is rejected as the term "type" renders the claim indefinite. Applicants argue that the specification contains a written description correlating with the claim at page, and that

that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention since the term. Examiner respectfully disagrees. The disclosure in the specification at page 8, lines 5-22 exemplifies the term, but does not define it. Furthermore, the court in Ex parte Copenhaver held that the addition of the word "type" to an otherwise definite expression extends the scope of the expression so as to render it indefinite. 109 U.S.P.Q. 118 (Bd. App. 1955); MPEP § 2173.05 (b)(E). In this case, the scope of the claim is indefinite because of the addition of the term "type" to otherwise definite terms polyolefins of hydrogenated polybutene, polyolefins of non-hydrogenated polybutene, polyolefins of hydrogenated polydecene, and polyolefins of non-hydrogenated polydecene, and the rejection is maintained.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(A) Claims 1-16, 70-92, 94, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. (EP 0874017) taken with Dubief et al. (U.S. Pat No. 5,679,357).

The rejection is maintained for the reasons of record.

(B) Claims 17-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. and Dubief et al. as applied to claims 1-16, 70-71, 72-80, and 94-95 above, and further in view of Restle et al. (U.S. Pat. No. 6,039,936).

The rejection is maintained for the reasons of record.

(C) Claims 44 - 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. and Restle et al., as applied to claims 17-42 above, and further in view of Decoster et al. (U.S. Pat. No. 6,150,311).

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The rejection is maintained for the reasons of record.

(D) Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al., Restle et al., and Dubief et al., as applied to claims 1-92 and 94-95 above, and further in view of Ramin (U.S. Pat. No. 6,099,826).

The rejection is maintained for the reasons of record.

Response to Arguments

Applicant's arguments filed on August 29, 2001 have been fully considered but they are not persuasive.

Applicants argue that the obviousness rejection based on the combined teaching of the Dalle and Dubief lacks the required the motivation to establish prima facie obviousness. Applicants state that the rejection is made "after admitting that Dalle lacks a specific mention that that the compositions comprise a conditioner containing oil, wax, or ceramides", citing only a part of the examiner's statement. Examiner views that this argument is not responsive to the examiner's full statement made on Office Action on page p. 4, lines 6-9, as examiner clearly pointed out that Dalle does teach to use ceramide in the invention in general. As mentioned in the Office Action, Dalle states in p. 5, lines 47 -57:

[The emulsions of the invention] are useful for personal care applications such as on hair, skin . . . It can likewise be use[d] in hair shampoos, hair conditioners, mousses. . . to provide conditioning benefits. . . . It is likewise useful as a delivery system for oil and water soluble substances such as vitamins, organic sunscreens, ceramides, pharmaceuticals and the like. *(emphasis added)*

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The only deficiency of Dalle is that the ceramides are not exemplified, and it is cured by Dubief which teaches the specific types of ceramides and/or glycosphingolipids beneficial for hair treatment

composition, rendering one of ordinary skill in the art motivation to combine the teachings of the two references.

Applicants also argue that teachings of Dalle and Dubief teach away from modifying Dalle's composition by adding the ceramides and/or glyceceramides in Dubuief. Examiner respectfully disagrees. The nature of the teaching must be weighed in substance. See In re Gurley, 27 F.3d 551, 554. [citation omitted]; see also MPEP § 2145 (X). In this case, applicants point to the section of Dalle which teaches that anionic and cationic surfactants used in emulsion polymerization can cause irritation and can affect the stability of the products. Examiner views that here Dalle merely discusses the *possibility* of the drawback caused by the ionic surfactants used in *emulsion polymerization*, which is clearly not at issue in this case. Examiner asserts that this teaching does not necessarily deter a skilled worker from employing the cationic surfactants of Dubief, when, in fact, Dalle teaches of employing cationic surfactants, such as tetramethylammonium hydroxides, tallow trimethylammonium hydroxide, and their salts. See p. 4, lines 18 – 37. Dubief teaches the ceramides and/or glycoceramides of the instant claims to be combined with specific cationic surfactants, including tetraalkylammonium halides and quaternary ammonium salt derived from tallow fatty acids, which belong to the same genus of the compounds disclosed in Dalle. See Dubief, col. 3, lines 17 – 43. Thus, it is viewed that one of ordinary skill in the art would not at all have been deterred from combining the teachings of Dalle with Dubief, and in fact have found a strong suggestion from both references that the specific cationic surfactants disclosed in Dubief are suitable and safe to use in Dalle's composition. Furthermore, applicants' arguments regarding cationic surfactants in Dalle are not convincing as they are not commensurate in scope with the instant claims which recite open

“comprising” language and nowhere exclude cationic surfactants. Examiner thus maintains the position that a skilled worker would have found motivation to modify Dalle by combining the ceramide and/or glycosphingolipid of Dubief for the expectation of obtaining the beneficial results stated in Dubief, and concludes that applicants have not overcome the prima facie obviousness rejection of the instant claims.

Examiner notes that the applicants’ arguments against the rejections are incomplete, as applicants did not discuss Restle, Decoster, and Ramin applied against the claims, explaining how the claims avoid the references or distinguish from them. Particularly, on page 26, lines 14-16 of the Response, applicants state that the deficiencies of Dalle and Restle were discussed in a previous section, when in fact no discussion of Restle is provided.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
November 8, 2001



DIANA DUDASH
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